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| 09/531,956 | 03/21/2000 | Bryan M. Eagle III | 11459/1 | 6873 |
| 23838 | 7590 | 03/10/2006 | EXAMINER | |
| KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005 | | | MORGAN, ROBERT W | |
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| | | | 3626 | |

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/531,956

Applicant(s)

EAGLE, BRYAN M.

Examiner

Robert W. Morgan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 129, 140 and 141 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 129, 140 and 141 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/3/06 has been entered.

Notice to Applicant

2. In the amendment filed 12/21/05, the following the occurred: Claim 129 has been amended. Now claims 129 and 140-141 are presented for examination.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 129, 140, and 141 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,711,548 to Rosenblatt.

As per claim 129, Rosenblatt teaches air travel scheduling system and method for scheduling non-scheduled flight using a distributed computer network such as the Internet (see: column 4, lines 44-47). Where Fixed Base Operators (FBO's), through subscription to a directory service or similar listing available over the distributed computer network make their aircraft available to air travelers (see: column 4, lines 47-50).

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--the claimed receiving availability information including predetermined reservation criteria for each of several unscheduled privately owned aircraft, said reservation criteria including a departure location, a departure time constraint, a minimum number of passengers, and minimum total payment required to reserve the private aircraft is met by travelers (14, Fig. 1) accessing the directory service (12, Fig. 1) via a computer connection and specifying (32, Fig. 2) a departure site, date, destination (34, Fig. 2) and the number of passenger (38, Fig. 2) (see: column 6, lines 7-17). In addition, each independent charter services have its own cost structures that govern its charges for charter flights (see: column 7, lines 40-42);

--the claimed posting via a computer network the availability information on an electronic medium is met by the directory service posting seat availability via a web site (see: column 50-55);

--the claimed receiving reservation bids from a plurality of independent passengers, each of the reservation bids including a specific destination request and a payment offer is met by travelers (14, Fig. 1) accessing the directory service (12, Fig. 1) via a computer connection and specifying (32, Fig. 2) a departure site, date, destination (34, Fig. 2) and the number of passenger (38, Fig. 2) (see: column 6, lines 7-17). In addition, Rosenblatt teaches that payment is made to the charter flight operator by the network booking agency on the basis of the alternative scales for network charter bookings less server commissions (see: column 7, lines 60-63);

--the claimed selecting the number of received reservation bids, wherein the selected bids collectively match said criteria for an identified private aircraft is met by the system that offers customized itineraries through an efficient matching of aircraft resources with passenger needs (see: column 5, lines 55-57). In addition, Rosenblatt teaches that aircrafts are assigned according

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distance to be traveled, number of passengers and location of particular aircraft on the specified departure date (see: column 6, lines 18-27);

--the claimed communicating to each of the independent passengers associated with selected bids a first notification of the acceptance is met by all participants being notified in advance of a proposed schedule as soon as the flight has been booked (see: column 6, lines 64-66);

--the claimed communicating to an owner of the identified private aircraft a second notification of the acceptance is met by all participants being notified in advance of a proposed schedule as soon as the flight has been booked (see: column 6, lines 64-66); and

--the claimed scheduling a flight for the identified private aircraft substantially according to the flight schedule is met by the aircrafts being assigned according to the location of particular aircraft on the specified departure date (see: column 6, lines 18-27).

Rosenblatt fails to explicitly teach:

--the claimed accepted the selected reservation bids; and

--the claimed transmitting to the owner of the identified private aircraft a passenger list corresponding to the selected reservation bids and a flight schedule that is substantially consistent with the departure time constraint, the departure location, and specific destination request.

However, Rosenblatt teaches that all participants are notified in advance of a proposed schedule as soon as the flight has been booked (see: column 6, lines 64-66). The Examiner considers notification of the flight being booked as acceptance of the reservation. In addition, Rosenblatt also teaches that once a customized charter flight has been booked, its flight plan is

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filed with the FAA in the same manner as that followed by the general aviation users of air space. The Examiner considers the flight plan to include a passenger list corresponding to the selected reservation bids and a flight schedule that is substantially consistent with the departure time constraint, the departure location, and specific destination request. One of ordinary skill in the art at the time the invention was made would have found it obvious to include transmitting a passenger list to the private aircraft owners within the travel scheduling system as taught by Rosenblatt with the motivation of providing aircraft owners with accurate and updated passenger information thereby utilizing all the seats that are available in order to satisfy the cost of the flight.

As per claim 140, Rosenblatt teaches a method for utilizing private aircraft as a public passenger service comprising:

- the claimed reservation service operated by a reservation service owner is met by the air travel schedule directory service (12, Fig. 1);

- the claimed plurality of unscheduled airplanes, each owned and operated by a private airplane owner, each airplane owner independent of another such airplane owner and independent of said reservation served owner is met by the fixed base operators (FBO's) (16, Fig. 1) and other charter-type flight providers (20, Fig. 1);

- the claimed said reservation service to receive electronically from each airplane owner a flight availability each of said flight availabilities including a departure location, a list of possible destination locations, a departure time constraint, and a minimum total payment, said minimum total payment expressed as a function of available seats and price per seat is met by the directory service that maintains a current and schedule location of all aircraft available through the

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services as well as updating the listing with every reservation (see: column 6, lines 35-41). In addition, travelers (14, Fig. 1) accessing the directory service (12, Fig. 1) via a computer connection and specifying (32, Fig. 2) a departure site, date, destination (34, Fig. 2) and the number of passenger (38, Fig. 2) (see: column 6, lines 7-17). Furthermore, each independent charter services have its own cost structures that govern its charges for charter flights (see: column 7, lines 40-47);

--the claimed said reservation to post via a computer network each of said flight availabilities on an electronic medium is met by the directory service posting seat availability via a web site (see: column 50-55);

--the claimed said reservation service to receive reservation bids electronically from a plurality of independent passengers, said passengers independent of said reservation service owner and said airplane owners, each of said reservation bids including a specific destination request and a payment offer is met by travelers (14, Fig. 1) accessing the directory service (12, Fig. 1) via a computer connection and specifying (32, Fig. 2) a departure site, date, destination (34, Fig. 2) and the number of passenger (38, Fig. 2) (see: column 6, lines 7-17). In addition, Rosenblatt teaches that payment is made to the charter flight operator by the network booking agency on the basis of the alternative scales for network charter bookings less server commissions (see: column 7, lines 60-63);

--the claimed said reservation service to accept a number of said reservation bids and to reserve a matching flight availability if the number collectively satisfies the minimum total payment, departure location, destination location, and departure time constraints associated with said matching flight availability is met by the system that offers customized itineraries through

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an efficient matching of aircraft resources with passenger needs (see: column 5, lines 55-57). In addition, Rosenblatt teaches that aircrafts are assigned according distance to be traveled, number of passengers and location of particular aircraft on the specified departure date (see: column 6, lines 18-27). Furthermore, each independent charter services have its own cost structures that govern its charges for charter flights (see: column 7, lines 40-47). In addition, Rosenblatt teaches that payment is made to the charter flight operator by the network booking agency on the basis of the alternative scales for network charter bookings less server commissions (see: column 7, lines 60-63);

--the claimed said reservation service to transmit a notification of said reserved flight availability to the owner of said airplane associated with said reserved flight availability is met by all participants being notified in advance of a proposed schedule as soon as the flight has been booked (see: column 6, lines 64-66); and

--the claimed said reservation service to transmit a notification of said acceptance to each of the passengers associated with the accepted reservation bid is met by all participants being notified in advance of a proposed schedule as soon as the flight has been booked (see: column 6, lines 64-66).

Rosenblatt fails to teach:

--the claimed said reservation service to transmit electronically to the owner of said airplane associated with said reserved flight availability a passenger list and a flight schedule that is substantially consistent with said departure time constraints, said departure location, and said destination location;

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--the claimed said reservation service to schedule a flight for the airplane substantially according to the flight schedule;

--the claimed said airplane to fly a flight substantially according to said flight schedule;

--the claimed said reservation service to collect a payment from each of the passengers, said payment corresponding to said payment offer; and

--the claimed said reservation service to transfer said collect payment to said owner of said airplane associated with said reserved flight availability.

However, Rosenblatt teaches that all participants are notified in advance of a proposed schedule as soon as the flight has been booked (see: column 6, lines 64-66). The Examiner considers the notification to all the parties to include an electronic transmission to the owner of the private airplane. In addition, Rosenblatt teaches that once a customized charter flight has been booked, its flight plan is filed with the FAA in the same manner as that followed by the general aviation users of air space. The Examiner considers that flight plan to include a passenger list and flight schedule in order to fly a flight substantially according to flight schedule. Furthermore, Rosenblatt teaches that a payment is made to the charter flight operator by the network booking agency on the basis of the alternative scales for network charter bookings less server commissions (see: column 7, lines 60-63). One of ordinary skill in the art at the time the invention was made would have found it obvious to include transmitting a passenger list and flight schedule in order to fly a flight substantially according to flight schedule within the travel scheduling system as taught by Rosenblatt with the motivation of providing aircraft owners with accurate and updated flight schedule information in order to satisfy the cost of the flight.

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As per claim 141, Rosenblatt teaches the claimed reservation service to terminate on of said flight availabilities if said reservation service fails to match a number of reservation bids with said flight availability such that said minimum total payment requirement is met. This feature is met by the minimum passenger booking per flight which represents a break-even point for operating cost vs. fare revenue, associated with selection of the aircraft type for a given trip assignment (see: column 10, lines 26-30). In addition, Rosenblatt teaches that data is needed to assembly the economics of operating "charter services" such as cost per operating hour that leads to projections of ticket prices (see: column 11, lines 56-61).

Response to Arguments

5. Applicant's arguments filed 12/21/05 have been fully considered but they are not persuasive. Applicant's arguments will be addressed herein below in the order in which they appear in the response filed 12/21/05.

At page 5 of the 12/21/05 response, Applicant directs the Examiner to a Declaration filed under 37 C.F.R § 1.132 along with evidence demonstrating Applicant arrived at his invention prior to filing date of the Rosenblatt invention. The Examiner respectfully submits that the documents submitted by the Applicant indicate that conception of the invention took place around September 14, 1999. However, Applicant has failed to provide specific evidence that he worked diligently from September 14, 1999 until an actual reduction to practice date, or that he worked diligently from prior to December 29, 1999 (constructive reduction to practice for the Rosenblatt reference) until March 21, 2000.

MPEP § 2138.06 states the following:

An applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966)

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(Merely stating that there were no weeks or months that the invention was not worked on is not enough.); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964)(statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); *Fitzgerald v. Arbib*, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); *Kendall v. Searles*, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (*Diligence requires that applicants must be specific as to dates and facts.*) (*Emphasis added*)

The declaration includes a copy of a printout from the Applicant's hard drive, thereby alleging diligence in reduction to practice of the instant invention. The Applicant also provides screen shots with a "create date" and "modified" date however, the evidence submitted by the Applicant does not account for any of the time lapses indicated by the date of the screen shots to the date of the Rosenblatt reference (filed 12/29/99). As such, it is submitted that the Applicant has failed to provide evidence to fully account for the time period during which due diligence must be established.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W. Morgan whose telephone number is (571) 272-6773.

The examiner can normally be reached on 8:30 a.m. - 5:00 p.m. Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert Morgan
Robert Morgan
Patent Examiner
Art Unit 3626